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PATENT
Attorney Docket No. 018158-004990US
Client Ref. No. VX-1012 C3 US

TOWNSEND and TOWNSEND and CREW LLP

By: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CARL F. KNOPP et al.

Application No.: 10/632,462

Filed: August 1, 2003

For: AUTOMATED LASER
WORKSTATION FOR HIGH
PRECISION SURGICAL AND
INDUSTRIAL INTERVENTIONS

Confirmation No. 3822

Examiner: David M. Shay

Technology Center/Art Unit: 3739

APPELLANTS' REPLY BRIEF UNDER
37 CFR §41.41(a)

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Examiner's Answer mailed February 23, 2007 in the
above-referenced application, Appellants submit this Reply Brief.

REMARKS

The Examiner's Answer withdraws the rejection of claim 3 under 35 U.S.C. §112, second paragraph, the rejection of claims 1-5, 7-9, 11-13 under 35 U.S.C. §102(b) based on Pflibsen, and the rejection of claims 1-15 under the judicially created doctrine of obviousness-type double patenting over U.S. Patent 5,966,157. No new grounds of rejection were introduced.

The rejection of claims 1-5, 7, 9, 11, and 14 under 35 U.S.C. §102(b) based on Bille, the rejection of claims 1-7, 9, 11, and 14 under 35 U.S.C. §103(a) based on Bille and the '718 patent, and the rejection of claims 10 and 15 under 35 U.S.C. §103(a) based on Bille, the '718 patent, and Kohayakawa remain applicable to the appealed claims.

The Examiner rebuts Appellants' arguments for the patentability of independent claims 1 and 11 solely on the basis that the broadest reasonable interpretation of Appellants' claimed "natural tissue structure" is met by the uncut tissue remaining adjacent Bille's incisions (Examiner's Answer, §10, first paragraph). Appellants respectfully but emphatically disagree.

Firstly, Appellants' claims set forth that a natural tissue structure is detected, and an electrical signal is generated based on the position of the natural tissue structure to stabilize the beam of treatment light energy. Even if, *arguendo*, Bille's uncut tissue is considered the claimed "natural tissue structure," Bille does not refer to detecting the uncut tissue or utilizing the locations of these uncut portions to provide positional reference. Rather, Bille is directed to steering its laser beam with reference to the grid of incisions cut into the cornea (col. 7, lines 44-60).

Secondly, while Appellants do not dispute the standard cited by the Examiner, as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (PTO should give claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art), Appellants submit that the Examiner has misapplied the standard such that Appellant's claimed "natural tissue structure" covers the exact opposite of what the term reasonably conveys. In particular, the Examiner's contention that a "natural tissue structure" is

met by uncut tissue adjacent an artificial incision is, in effect, encouraging the Board to take the view that "natural tissue structure" can be interpreted to cover artificial incisions in the cornea.

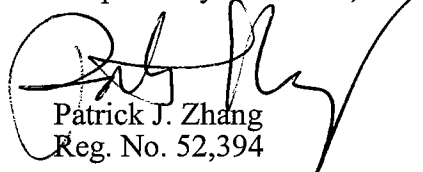
In light of Appellants' specification, which sets forth that the "natural tissue structure" may, for example, be a limbal structure of the eye (p. 18, paragraphs 44 and 45), Appellants submit that neither Bille's incisions nor its adjacent uncut tissue falls within the broadest reasonable interpretation of the term "natural tissue structure," as it would be interpreted by one of ordinary skill in the art. *Phillips*, 415 F.3d 1303. Therefore, Bille fails to disclose or suggest all the features of Appellants' independent claims 1 and 11. Appellants further reiterate that Appellants' claimed non-invasive approach constitutes a patentable advance over the approach taken by Bille.

As the '718 patent and Kohayakawa fail to make up for the above deficiency in Bille, claims 1 and 11 are patentable. Claims 2-10 and 12-15 are patentable at least because they respectively depend from claims 1 and 11.

CONCLUSION

In view of the foregoing remarks and those previously set forth in the Appeal Brief, Appellants respectfully maintain the request that the appealed rejections be reversed.

Respectfully submitted,



Patrick J. Zhang
Reg. No. 52,394

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 650-326-2422